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36876 7590 03/18/2009 MEADWESTVACO CORPORATION ATTN: IP LEGAL DEPARTMENT 1021 Main Campus Drive Raleigh, NC 27606				
EXAMINER DONLON, RYAN D				
ART UNIT		PAPER NUMBER		
3695				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketadministrator@mwv.com

Office Action Summary

Application No.

10/537,636

Applicant(s)

KUMAR ET AL.

Examiner

RYAN D. DONLON

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10-20, 23, 42-45, 51-61, 64 and 83 is/are pending in the application.
- 4a) Of the above claim(s) 5-9, 21, 22, 24-41, 46-50, 62, 63, 65-82 and 84-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10-20, 23, 42-45, 51-61, 64, and 83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Requirement for Information

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

37 CFR 1.105 Request

2. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

3. In response to this requirement, please provide precisely which portion(s) of the disclosure provide the written description and enablement support for the limitations in the previously presented, currently amended and amended claims.

4. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Election/Restrictions

5. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, independent claim(s) 1, 42 and 83 and their respective dependent claims are drawn to a method, system, and article of manufacture for receiving one or more locations and assessing risk associated with one or more locations.

6. Group II, independent claim(s) 5, 46 and 85 and their respective dependent claims, drawn to method, system, and article of manufacture for receiving an event details, receiving one or more locations and automatically assessing risk associated with one or more locations based on the event type.

7. Group III, independent claim(s) 9, 50 and 89 and their respective dependent claims, drawn to method, system, and article of manufacture for receiving landmark information including CAP and PML information; and automatically assessing risk associated with the location based on the CAP and PML.

8. Group IV, independent claim(s) 21, 62 and 90 and their respective dependent claims, drawn to method, system, and article of manufacture for receiving location information, performing PML calculations for the peril at that location, and automatically assessing risk associated with the location.

9. Group V, independent claim(s) 24, 41, 65, 82, 84 and 92 and their respective dependent claims, drawn to method, system, and article of manufacture for receiving a location, determining target data items that fall within one or more proximity areas around the center and representing target data items.

10. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in these claims is the practice of receiving one or more locations and assessing risk associated with one or more locations. This claim element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art. US Patent 5,809,478 teaches the practice of receiving one or more locations and assessing risk associated with one or more locations (assessing risk based upon state driver's licenses).

11. The inventions listed as Groups I-IV and Group V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common special technical feature in Groups I-IV is the practice of receiving one or more locations and assessing risk associated with one or more locations not present in Group V. The common special technical feature in Group V is the practice of determining

target data items that fall within one or more proximity areas around the center and representing target data items, not present in Groups I-IV.

12. During a telephone conversation with Janaki Davda on 26 February 2009 a provisional election was made without traverse to prosecute the invention of Group I claims 1-4, 10-20, 23, 42-45, 51-61, 64, and 83. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-9, 21-22, 24-41, 46-50, 62-63, 65-82 and 84-92 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

14. The drawings are objected to because the drawings are blurred or illegible and of poor quality. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the

replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 1-4 10-20, 23, 42-45, 51-61, 64, and 83 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
17. Claims 1-4 10-20, 23 recite a process comprising the steps of receiving and assessing. Based on Supreme Court precedent, a proper process must be tied to a particular machine or apparatus, or transforms a particular article to a different state or thing. (*See In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should

positively recite the machine or apparatus, or transform a particular article to a different state or thing.

18. Claims 42-45, 51-61, and 64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This claim is directed to computer software without a computer readable medium, therefore this claim is directed to non-functional abstract ideas which are not made statutory by also claiming the computer readable medium thus claiming an statutory article of manufacture. Software per se is non-statutory subject matter unless it claimed in *combination* with an appropriate computer readable medium. The applicant is encouraged to amend the claim to a proper computer readable medium (not e.g. a signal) encoded with said non-functional descriptive material that can function with a computer to effect a useful, concrete and tangible result.

19. Claim 83 is rejected under 35 U.S.C. 101 because in the broadest reasonable interpretation of the claimed invention, the system is directed to merely software without the support of hardware to provide functionality and thus non-statutory. Therefore the claimed system consists only of non-statutory subject matter and therefore does not constitute a statutory process, machine, manufacture, or composition of matter.

20. Claims 15 and 56 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. This claim lacks concreteness because one of ordinary skill at the time of the invention would not be reasonably able to repeat the step of "attempting" and reasonably certain of a repeatable result.

21. **Examiner Notes:** When amending the claims to overcome these rejections, the Examiner recommends amending the body of them claim(s), rather than simply amending the preamble(s) (see *Ex parte* Langemyr Appeal No. 2008-1495 (May 28, 2008)).

Claim Rejections - 35 USC § 112

22. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

23. Claims 3-4, 11, 44-45 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

24. As per claims 3, 4, 12, 15, 16, 19, 20, 44, 45, 53, 56, 57, 60 and 61 it is unclear how "enabling" further limits the scope of the parent claim. Simply "enabling" is not a positive recitation of the claim elements because "enabling" does not specifically affect an outcome, but rather grants permission. Merely providing permission for an step or function is not a positively recited limitation, but rather renders the "enabled" elements optional as these elements may or may not affect their "enabled" step or function. Therefore the Examiner will interpret the "enabled" elements of these claims are as optional.

25. As per claims 18 and 59, it is unclear how these claims further limit their parent claims. These claims merely recite that data is capable of being displayed on a map,

however these claims fail to recite a method step or structure for doing so. Therefore the Examiner will interpret the “capable” elements of these claims as intended use.

26. As per claim 15 and 56, it is unclear how these claims further limit their parent claims. These claims recite “attempting to”, which does not positively recite a limitation. This “attempting” does not impart a clear distinction if step or function actually takes place, but rather that an attempt was made. One of ordinary skill in the art would not be reasonably apprised of how to clearly determine the metes and bounds of “attempting to”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 10-12, 14-17, 19-20, 23, 42-45, 51-53, 55-58, 59-31, 64 and 83 are rejected under 35 U.S.C. 102(b) as being anticipated by Hargrove Jr. et al., US 5897613 (hereinafter Hargrove).

27. As per **claim 1** (Currently Amended):

Hargrove discloses a computer-implemented method for evaluating risk associated with underwriting an insurance policy, comprising:

receiving one or more locations to be covered under the insurance policy (see at least column 8); and

automatically assessing risk associated with the one or more locations, including generating rating results for one or more perils, wherein the rating results indicate whether that peril may occur at each of the one or more locations (see at least column 6, lines 42-56 and column 5 lines 21-27).

As per **claim 2** (Currently Amended):

Hargrove discloses a method of claim 1, wherein automatically assessing further comprises:

applying at least one business rule (see at least column 7 lines 1-9).

28. As per **claim 3** (Original):

Hargrove discloses a method of claim 1, further comprising:

enabling selection of at least one of an underwriting analysis and a risk analysis (see at least column 6 line 42-56).

29. As per **claim 4** (Original):

Hargrove discloses a method of claim 1, further comprising:

enabling setup of an event (hail) that may impact assessment of risk (see at least column 5 lines 21-27).

30. As per **claim 10** (Previously Presented):

Hargrove discloses a method of claim 1, wherein a location may be selected by

at least one of a company search, an address search (legal description), or uploading a file (see at least column 8 lines 35-49. For the purposes of applying prior art, the Examiner has interpreted this claim in the alternative as it has been presented. Any dependant claims relying on the unconsidered alternatives of this claim for antecedent bases will be rejected under the same rationale as this claim).

31. As per **claim 11** (Original), the claim recites "The method of claim 10, wherein selection of a location by company search further comprises:

receiving at least part of a *company name*;

searching for the company name in a business data store;

and retrieving at least one address from the searching" (emphasis added). The antecedent basis for this claim is an alternative element of claim 10, specifically "a company search". This claim is therefore rejected under the same rationale as claim 10 above, since it is a further limitation of an unconsidered alternative element..

32. As per **claim 12** (Original), This claim recites "The method of claim 11, further comprising: determining that there are ambiguous addresses for the *company name*; and enabling selection of at least one of the addresses" (emphasis added). This claim depends from claim 11 above which further limited an alternative element of claim 10. This claim is therefore rejected under the same rationale as claim 10 above, since it is a further limitation of an unconsidered alternative element.

33. As per **claim 14** (Original), the claim recites, "The method of claim 10, wherein selection of a location by uploading a file further comprises: associating data in the file with a predefined format." The antecedent basis for this claim is an unconsidered alternative element of claim 10, specifically "by uploading a file". This claim is therefore rejected under the same rationale as claim 10 above, since it is a further limitation of an unconsidered alternative element.

34. As per **claim 15** (Original):

Hargrove discloses a method of claim 10, further comprising:

attempting to automatically geocode the selected location (see at least column 8 lines 15-65, wherein there is disclosed a field ID automatically assigned).

35. As per **claim 16** (Original):

Hargrove discloses a method of claim 15, wherein the location can not be automatically geocoded and further comprising:

enabling use of a spatial interface to manually geocode the location (see at least column 8 lines 15-65 wherein there is disclosed a manual selection of fields).

36. As per **claim 17** (Original):

Hargrove discloses a method of claim 1, wherein automatically assessing risk further comprises:

performing a proximity analysis (see at least the points in column 7 lines 60-67

and column 8 lines 15-65).

37. As per **claim 19** (Currently Amended):

Hargrove discloses a method of claim 1, further comprising:

enabling drilldown into details of at least a portion of the rating results (see at least column 4 lines 33-50 and column 7 lines 9-21, wherein it is disclosed that rates may be displayed and determined on a field by field basis)

38. As per **claim 20** (Previously Presented):

Hargrove discloses a method of claim 1, further comprising:

enabling exporting (displayed on monitor) of the rating results (policies) (see at least column 7 lines 22-43).

39. As per **claim 23**, (Original):

Hargrove discloses a method of claim 1, wherein assessing risk associated with the location further comprises:

assessing risk based on at least one of unbound policies and bound policies (see at least column 5 lines 43-61).

40. As per **claim 42** (Currently Amended), "An article of manufacture including a program for evaluating risk associated with underwriting an insurance policy, wherein the program causes operations to be performed, the operations comprising:

receiving one or more locations to be covered under the insurance policy;
automatically assessing risk associated with the one or more locations, including generating rating results for one or more perils, wherein the rating results indicate whether that peril may occur at each of the one or more locations", this claim is rejected under the same rationale as claim 1 above.

41. As per **claim 43** (Currently Amended), "The article of manufacture of claim 42, wherein the operations for automatically assessing risk further comprise: applying at least one business rule." This claim is rejected under the same rationale as claim 2 above.

42. As per **claim 44** (Original), "The article of manufacture of claim 42, wherein the operations further comprise: enabling selection of at least one of an underwriting analysis and a risk analysis." This claim is rejected under the same rationale as claim 3 above

43. As per **claim 45** (Original), "The article of manufacture of claim 42, wherein the operations further comprise: enabling setup of an event that may impact assessment of risk." This claim is rejected under the same rationale as claim 4 above.

44. As per **claim 51** (Previously Presented), "The article of manufacture of claim 42, wherein a location may be selected by at least one of a company search, an address

search, or uploading a file." This claim is rejected under the same rationale as claim 10 above.

45. As per **claim 52** (Original), "The article of manufacture of claim 51, wherein the operations for selection of a location by company search further comprise:

receiving at least part of a company name;

searching for the company name in a business data store;

and retrieving at least one address from the searching". This claim is This claim is rejected under the same rationale as claim 11 above.

46. As per **claim 53** (Original), "The article of manufacture of claim 52, wherein the operations further comprise: determining that there are ambiguous addresses for the company name; and enabling selection of at least one of the addresses." This claim is rejected under the same rationale as claim 12 above.

47. As per **claim 55** (Original), "The article of manufacture of claim 51, wherein the operations for selection of a location by uploading a file further comprise:

associating data in the file with a predefined format." This claim is rejected under the same rationale as claim 14 above.

48. As per **claim 56** (Original), "The article of manufacture of claim 51, wherein the operations further comprise:

attempting to automatically geocode the selected location." This claim is rejected under the same rationale as claim 15 above.

49. As per **claim 57**, (Original), "The article of manufacture of claim 56, wherein the location can not be automatically geocoded and wherein the operations further comprise: enabling use of a spatial interface to manually geocode the location." This claim is rejected under the same rationale as claim 16 above.

50. As per **claim 58** (Original), "The article of manufacture of claim 42, wherein the operations for automatically assessing risk further comprise:
performing proximity analysis." This claim is rejected under the same rationale as claim 17 above.

51. As per **claim 60**, (Original), "The article of manufacture of claim 59, wherein the operations further comprise: enabling drilldown into details of at least a portion of the rating results". This claim is rejected under the same rationale as claim 19 above.

52. As per **claim 61** (Original), "The article of manufacture of claim 59, wherein the operations further comprise: enabling exporting of the rating results." This claim is rejected under the same rationale as claim 20 above.

53. As per **claim 64** (Original), "The article of manufacture of claim 42, wherein the operations for assessing risk associated with the location further comprise:

assessing risk based on at least one of unbound policies and bound policies."

This claim is rejected under the same rationale as claim 23 above.

54. As per **claim 83**, (Currently Amended), "A computer system having logic for evaluating risk associated with underwriting an insurance policy, wherein the logic is executed by the computer system, the logic comprising:

receiving one or more locations to be covered under the insurance policy;

automatically assessing risk associated with the one or more locations, including generating rating results for one or more perils, wherein the rating results indicate whether that peril may occur at each of the one or more locations." This claim is rejected under the same rationale as claim 1 above.

Claim Rejections - 35 USC § 103

55. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

56. Claims 13, 54, 18, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hargrove.

As per **claim 13** (Original):

Hargrove does not specifically disclose a method of claim 10, wherein selection of a location by an address search further comprises:

receiving a street address and at least one of a zip code and a city and state.

However Hargrove does disclose entering the "legal description" of the location. It would have been obvious (if not inherent) to one skilled in the art at the time of the invention to include a street address and at least one of a city, state or zip code in a legal description because this would have been a well known standard to identify a location for the postal service.

57. As per **claim 54** (Original), "The article of manufacture of claim 51, wherein the operations for selection of a location by an address search, further comprise:

receiving a street address and at least one of a zip code and a city and state."

This claim is rejected under the same rationale as claim 13 above.

58. As per **claim 18** (Previously Presented):

Hargrove does not disclose a method of claim 1, wherein the rating results for at least one peril are capable of being displayed on a map.

59. However does disclose location ratings results for locations for peril (column 5 lines 22-27) and displaying data for a particular location in (see at least column 8 lines 15-34) and also a policy map (column 11 lines 11-21). Rates on a field by field basis are also disclosed (see at least column 4 lines 33-49). It would have been obvious for the

system to be capable to display the ratings for the fields on the map because this would have been a similar display to the well known predictive weather map for helping to identify the risk associate with a policy or crop risks.

60. As per **claim 59**, (Previously Presented), "The article of manufacture of claim 42, wherein the rating results for at least one peril are capable of being displayed on a map." This claim is rejected under the same rationale as claim 18 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN D. DONLON whose telephone number is (571)270-3602. The examiner can normally be reached on Monday through Friday 7:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. D. D./
Examiner, Art Unit 3695
March 5, 2009

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 3695